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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,860	06/11/2001	Tore Danielssen	E-1024	5304

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	10

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/830,860	DANIELSSEN ET AL.
	Examiner	Art Unit
	Rip A. Lee	1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This office action follows a response filed on June 26, 2003. Applicants have amended claims 6 and 7, replacing the term "comprising" with "consisting essentially of."

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 210 882 to Clarke *et al.* for the same reasons set forth in the previous office action (Paper No. 8).

5. Claims 1-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,143,808 to Sack *et al.* for the same reasons set forth in the previous office action.

6. Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sack *et al.* in view of U.S. Patent No. 5,844,037 to Lundgard *et al.* for the same reasons set forth in the previous office action.

Response to Arguments

7. The Applicants traverse the rejection of claims 6 and 7 under 35 U.S.C. 102(b) as being anticipated by GB 2 210 882 to Clarke *et al.* Applicant's arguments have been considered fully, but they are not persuasive. Specifically, the Applicants contend that the specific combination of microsilica and talc in the specified amounts are nowhere to be found in the reference.

A review of the teachings in Clarke *et al.* is instructive. The patent discloses a particulate filler comprising the following fractions:

(*i*) 2-35 % in the 0.1-1.0 μ range (microsilica) and/or
(*ii*) 30-80 % in the 1-50 μ range (talc, quartz powder; or fly ash) and
(*iii*) 5-40 % in the 50-250 μ range (quartz grit, sand)

Clearly, the combination of microsilica and talc in the claimed 15/1 to 1/15 weight ratio (*i.e.*, 93.75 % to 6.25 %) is encompassed in the teachings elucidated above. An example would be the following blend whose composition flows naturally from the general teachings of the prior art:

(*i*) 35 % in the 0.1-1.0 μ range (microsilica) and
(*ii*) 60 % in the 1-50 μ range (talc) and
(*iii*) 5 % in the 50-250 μ range (quartz grit)

That the present claims are amended to recite a filler blend "consisting essentially of" is insufficient to overcome the prior art. According to MPEP § 2111.03, the transitional phrase, "consisting essentially of" limits the scope of a claim to the specified materials and those that do not *materially* affect the *basic* and *novel* characteristics of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

The composition described in Clarke *et al.* is simply a mixture of inert particles as is the blend described in present claims 6 and 7. Since those materials which lie in the 50-250 μ range, that is, quartz grit or sand, would not materially affect the basic and novel characteristics of the claimed invention, it is deemed that the present claims are still ancticipated by the prior art.

With respect to the filler's usage, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP § 2111.02. There is no indication that the composition of Clarke *et al.* can not be made into the claimed articles of manufacture. As such, the composition still meets the claims.

8. The Applicants also traverse the rejection of claims 1-14 and 16-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,143,808 to Sack *et al.*, as well as the subsequent rejection of claims 15 and 20 over Sack *et al.* in view of U.S. Patent No. 5,844,037 to Lundgard *et al.*

The Applicants have pointed out that Sack *et al.* fails to teach specifically the combination of microsilica and talc in the prescribed weight ratio, presumably because microsilica is not mentioned in the text, but rather, as an afterthought, in claim 5. However, this does not disbar the fact that microsilica is, indeed, an element in the Markush group of acceptable mineral carriers described in Sack *et al.* That microsilica is mentioned in the claim itself provides even more impetus to use it. In fact, one having ordinary skill in the art would find it obvious to use a combination of minerals because Sack *et al.* indicates in the claim language that mixtures of filler can be used. Therefore, it is maintained that one having skill in the art would find it obvious to arrive at a mixture of at least equal proportions of talc and microsilica (*i.e.*, 1:1 ratio or 50/50 mix), thereby satisfying the weight ratio set forth in the present claims. Why such a notion is not obvious, in view of the claims, is not made entirely clear by Applicants.

The discussion of the contents of Examples 3 and 4 is less convincing. These were cited to show that microsilica is truly an aspect of the invention, rather than an afterthought. Applicants also submit that the present invention is materially different from that of Sack *et al.*, stating that the composition described in the prior art is intended as additive for bitumen and other building materials. While this may be the case, the composition of the claims still lies

within the purview of the prior art because the term "comprising" in the present claims does not exclude any uncited components.

Finally, the data presented in the specification has been reviewed thoroughly. Applicants have provided cogent evidence of a synergistic effect of talc and microsilica when incorporated into PVC resin at a level of 10 wt % and when used in a 1/2 or 2/1 weight ratio (Table 3). However, at a filler level of 5 wt %, this effect appears to be lost (see Table 2, entry where talc/micorsilica ratio is 2/1).

It follows that one of ordinary skill in the art would not expect that such a synergistic effect would be observed beyond the 2/1 weight ratio exemplified in the data. One especially would lack reason to believe that a synergistic effect would be realized in the claimed 15/1 talc/microsilica ratio (*i.e.*, 93.75 % to 6.25 %). In fact, one would be inclined to expect such a composition to behave as a composition containing talc alone. Furthermore, the data suggest the possibility of the claimed synergy between filler only at low loadings. However, the claims are drawn to compositions containing anywhere from 3-400 wt % of filler, based on the amount of resin. It can not be seen, and one having ordinary skill in the art would not expect, similar results when the filler is incorporated into resin at the 100-400 % level. This, of course, does not take into account the fact that claims are drawn to polyolefin compositions, the resins of which are notoriously known as being incompatible with filler such as talc and silica. Therefore, it is not believed that the data of record purporting to establish unexpected results is commensurate in scope with the present claims. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

August 7, 2003

DAVID W. WU
SUPERVISORY PATENT EXAMINER
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